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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/685,366      10/10/00      PETERS      S      787446-2001.

020999  
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NEW YORK NY 10151

HM22/0629

EXAMINER

DAVIS, R

ART UNIT

PAPER NUMBER

1651

8

DATE MAILED:

06/29/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/685,366

Applicant(s)

PETERS ET AL.

Examiner

Ruth A. Davis

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 7-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

### **DETAILED ACTION**

1. Applicant's election with traverse of Group I, claims 1 - 6 in Paper No. 6 is acknowledged. The traversal is on the ground(s) that examiner did not provide evidence that a separate search would be required for the two groups and that there is not a serious burden on examiner to examine both groups together. This is not found persuasive because as stated in the election/restriction requirement, these methods are independent since they have different functions and/or they have different effects. They have acquired a separate status in the art as a separate subject for inventive effect and require independent searches (as indicated by the different classification). It is reiterated that the search for each invention is not co-extensive particularly with regard to the literature search. Further, a reference which would anticipate the invention of one group would not necessarily anticipate or even make obvious another group.

The requirement is still deemed proper and is therefore made FINAL.

The amendment filed May 5, 2001 has been received and entered. Newly entered claim 14 is drawn to the elected invention, therefore claims 1 – 6 and 14 will be considered on the merits. Claims 7 – 13 are withdrawn from consideration as being drawn to a non-elected invention.

### ***Specification***

2. The use of the trademark DOWICIL has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

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Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

3. Claims 2 and 6 are objected to because of the following informalities: the trademark DOWICIL should be capitalized. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 is drawn to a stable suspension however is indefinite because it is not clear if applicant intends to include a Markush group as the group listed is written in the alternative. Applicant may more clearly define the invention by either deleting "selected from the group consisting of" or by replacing "or egg" with "and a lecithin derived from egg."

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claims 1 – 5 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Ribier et al. (US 6,051,250).

Applicant claims a stable suspension comprising a nutrient, nutrient stabilizer and an aqueous solvent system wherein the nutrient is selected from an isoflavone, lycopene, lutein, coenzyme Q<sub>n</sub> where n is 1 – 12, or a mixture thereof the stabilizer is selected from a lecithin derived from soybean or egg, a hydrocolloid selected from xanthan gum, pectin, gelatin, guar gum, carrageenan, methylcellulose, hydroxypropyl celluloses, gum arabic or a mixture thereof, a surfactant selected from cetylpyridinium chloride, polysorbate 80, sorbitan monostearate, polyglycerol ester, a block of copolymer of propylene oxide, ethylene oxide, or a mixture thereof, Dowicil, or mixtures thereof.

Ribier et al. teach a stabilized composition formed from a lipid phase membrane in the form of a dispersion of an aqueous phase combined with stabilizing agents (abstract). The lipid phase membrane is a lecithin derived from soybean or egg (col.8 line 45-50), active agents are disclosed to include Coenzyme Q, specifically coenzyme Q<sub>10</sub> (Table I, col. 10 line 57), isoflavones and carotenoids (Table I, col.11 line 6-8). Other ingredients disclosed include gelatin, guar (Table I, col.11 line 30-35), cetylpyridinium chloride (Table I, col.13 line 32), and surfactant polyoxyethylene/polyoxypropylene copolymers (block copolymers of propylene oxide and ethylene oxide) (col.6 line 38-45).

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The reference anticipates the claimed subject matter.

8. Claims 1 – 3, 5 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Schweikert et al. (US 5,925,684).

Applicant claims a stable suspension comprising a nutrient, nutrient stabilizer and an aqueous solvent system wherein the nutrient is selected from an isoflavone, lycopene, lutein, coenzyme Q<sub>n</sub> where n is 1 – 12, or a mixture thereof, the stabilizer is selected from a lecithin derived from soybean or egg, hydrocolloid, surfactant selected from cetylpyridinium chloride, polysorbate 80, sorbitan monostearate, polyglycerol ester, a block of copolymer of propylene oxide, ethylene oxide, or a mixture thereof, Dowicil, or mixtures thereof.

Schweikert et al. teach a stable emulsion containing an aqueous phase, lecithin, a carotenoid and polyoxyethylene/polyoxypropylene block polymers (block copolymers of propylene oxide and ethylene oxide) (abstract, col.2 line 56 – col.3 line5, col.3 line 40-45) wherein lycopene is the preferred carotenoid (col.3 line 25-31) and the lecithin is soybean derived (col.2 line 4-9).

The reference anticipates the claimed subject matter.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 1 – 3, 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schweikert et al. (US 5,925,684).

Applicant claims a stable suspension comprising a nutrient, nutrient stabilizer and an aqueous solvent system wherein the nutrient is selected from an isoflavone, lycopene, lutein, coenzyme Q<sub>n</sub> where n is 1 – 12, or a mixture thereof, the stabilizer is selected from a lecithin derived from soybean or egg, a hydrocolloid, a surfactant, a Dowicil, or a mixtures thereof.

Schweikert et al. teach a stable emulsion containing an aqueous phase, lecithin, a carotenoid and polyoxyethylene/polyoxypropylene block polymers (block copolymers of propylene oxide and ethylene oxide) (abstract, col.2 line 56 – col.3 line5, col.3 line 40-45) wherein lycopene is the preferred carotenoid (col.3 line 25-31) and the lecithin is soybean derived (col.2 line 4-9).

Schweikert et al. do not teach the emulsion to include Dowicil. However, at the time of the invention, it would have been obvious to one of ordinary skill in the art to include Dowicil in

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the composition of Schweikert et al. because it was known in the art as a preservative in stable compositions. In support, Elson (US 5,510,391) teaches a composition containing the nutrient vitamin K combined with lecithin, water and Dowicil (abstract). King et al. (US 5,661,149) teach compositions comprising an active compound combined with the commercially available preservative, Dowicil 200 (col.3 line 35-61, Table 7). One of ordinary skill in the art would have been motivated to include Dowicil in the composition of Schweikert et al. because it was well known in the art for its claimed purpose, as demonstrated by the above references.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth A. Davis whose telephone number is 703-308-6310. The examiner can normally be reached on M-H (7:00-4:30); altn. F (7:00-3:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 703-308-4743. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

June 20, 2001



**LEON B. LANFORD, JR.**  
**PRIMARY EXAMINER**